



THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Patrick Cadet et al.

Art Unit : 1647

Serial No. : 10/080,917

Examiner : Robert S. Landsman

Filed : February 22, 2002

Title : NUCLEIC ACIDS ENCODING OPIATE RECEPTORS

**MAIL STOP ISSUE FEE**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

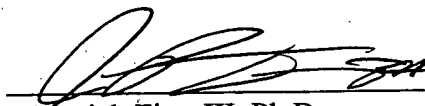
**LETTER REGARDING PATENT TERM ADJUSTMENT**

The Patent Term Adjustment (PTA) calculation included in the notice of allowance mailed March 20, 2006, for the above-referenced application indicates the PTA is 386 days. This PTA appears to be longer than appropriate.

Applicant believes that no fee is due at this time. Any fees that may be due, however, may be applied to Deposit Account No. 06-1050.

Respectfully submitted,

Date: June 15, 2006

  
J. Patrick Finn III, Ph.D.  
Reg. No. 44,109

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60360384.doc

CERTIFICATE OF MAILING BY EXPRESS MAIL

Express Mail Label No. EV741502902US

June 15, 2006  
Date of Deposit



DAE  
JPW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Patrick Cadet et al.

Patent No. : 7,094,892

Issue Date : August 22, 2006

Serial No. : 10/080,917

Filed : February 22, 2002

Title : NUCLEIC ACIDS ENCODING OPIATE RECEPTORS

Art Unit : 1647

Examiner : Robert S. Landsman

Conf. No. : 7797

**MAIL STOP PETITIONS (c/o OPLA)**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR §1.705(d)**

Applicants hereby petition for reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Attached herewith is a copy of the Issue Notification including a Determination of Patent Term Adjustment under 35 U.S.C. § 154(b), mailed August 22, 2006, for the above-referenced patent. The notification, as well as the face of the patent, states that the Patent Term Adjustment at issuance is 407 days. Reconsideration of the Patent Term Adjustment is respectfully requested.

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**CERTIFICATE OF MAILING BY FIRST CLASS MAIL**

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

October 13, 2006

Date of Deposit

Signature

Debra L. Miedema

Typed or Printed Name of Person Signing Certificate

### REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

A review of the Patent Term Adjustment History in the PAIR system shows that the United States Patent and Trademark Office (PTO) calculated the Patent Term Adjustment (PTA) as follows:

- 1) The PTO mailed a delayed first action on June 14, 2004. Applicants do not herein dispute the calculated PTO Delay of 419 days.
- 2) Applicants submitted a response to the non-final office action dated December 16, 2004, on April 20, 2005. Applicants do not herein dispute the calculated Applicant Delay of 35 days.
- 3) Applicants submitted a response to the final rejection dated June 6, 2005, on April 20, 2005. Applicants do not herein dispute the calculated Applicant Delay of 35 days. Applicants suggest, in good faith and candor, that additional Applicant Delay may be appropriate under 37 CFR. § 1.704(c)(8) for papers filed December 6, 2005, and on January 27, 2006.
- 4) The PTO mailed a Notice of Allowance on March 20, 2006, to which Applicants responded by submitting a "Response to Notice of Allowance" on June 15, 2006. Along with that filing, Applicants submitted a "Letter Regarding Patent Term Adjustment" (copy enclosed) indicating the calculated PTA was thought to be longer than appropriate. In the PAIR Patent Term Adjustment History, the document is entered as a "Miscellaneous Incoming Letter." Applicants respectfully disagree with the calculated Applicant Delay of 69 days for this paper and hereby request its removal.

### REMARKS

In consideration of the events described above, Applicants believe the PTA calculation of 407 days is incorrect.

Applicants believe the "Letter Regarding Patent Term Adjustment" filed with the issue fee payment should not be considered a "failure to engage in reasonable efforts" under 37 CFR §1.704(c)(10) given the discussion in MPEP 2733:

If a registered practitioner receives a notice of allowance with a patent term adjustment that is longer than expected, the practitioner should disclose the error to the Office in compliance with the practitioner's duty of candor and good faith in practice before the Office. Where the correct patent term adjustment is thought to be less than indicated by the Office, an application for term adjustment under 37 CFR 1.705(b) need not be filed. Instead, a letter could be filed with the issue fee payment, indicating that the term adjustment is thought to be longer than appropriate.

Applicants thus respectfully request the removal of 69 days of Applicant Delay, thus decreasing Applicant Delay from 139 days to 70 days and increasing the Total PTA from 407 to 476 days. Also, Applicants point in good faith and candor to an additional potential Applicant Delay related to the papers filed on December 6, 2005, and on January 27, 2006.

A copy of each of the following documents is provided herein:

- 1) Issue Notification mailed August 22, 2006;
- 2) Response to Notice of Allowance and Letter Regarding Patent Term Adjustment sent by Express Mail on June 15, 2006; and,
- 3) PTO date-stamped postcard indicating official receipt date of June 15, 2006.


Applicant : Patrick Cadet et al.  
Patent No. : 7,094,892  
Issued : August 22, 2006  
Serial No. : 10/080,917  
Filed : February 22, 2002  
Page : 4 of 4

Attorney's Docket No.: 09598-006001 / R1321-200

Enclosed is a check in the amount of \$200 for the fee required under 37 CFR §1.18(e).  
Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: October 13, 2006

  
\_\_\_\_\_  
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# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
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[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	ISSUE DATE	PATENT NO.	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,917	08/22/2006	7094892	09598-006001	7797

26191 7590 08/02/2006  
FISH & RICHARDSON P.C.  
PO BOX 1122  
MINNEAPOLIS, MN 55440-1022

## ISSUE NOTIFICATION

The projected patent number and issue date are specified above.

### Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) (application filed on or after May 29, 2000)

The Patent Term Adjustment is 407 day(s). Any patent to issue from the above-identified application will include an indication of the adjustment on the front page.

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571) 272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (703) 305-8283.

APPLICANT(s) (up to 18 names are included below, see PAIR WEB site <http://pair.uspto.gov> for additional applicants):

Patrick Cadet, Elmont, NY;  
George B. Stefano, Melville, NY;